

REMARKS

This Application has been carefully reviewed in light of the Final Action mailed December 19, 2006. Claims 10, 13-16, 19-21, 25, 27, 28, and 30-38 are pending in this Application. Applicant respectfully requests reconsideration and favorable action in this Application.

The drawings stand objected to under 37 C.F.R. §1.83(a) for not showing every feature specified in the claims. Attached herewith is a Replacement Sheet showing amendments made to FIGURE 4. FIGURE 4 has been amended to include the electrodes provided in the claimed invention as requested by the Examiner. The specification has also been amended to reflect the changes made to FIGURE 4. Therefore, Applicant respectfully submits that the drawings are in accordance with 37 C.F.R. §1.83(a).

The drawings stand objected to under 37 C.F.R. §1.84(p)(5) for including a reference character not mentioned in the specification. FIGURE 4 and the specification have been amended to address matters raised by the Examiner. Therefore, Applicant respectfully submits that the drawings are in accordance with 37 C.F.R. §1.84(p)(5).

Claims 10, 13-16, 19-21, 25, 27, 28, 31, 32, 34, 35, 37, and 38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Admitted Prior Art FIGURES 2 and 3 in view of Thomas, et al. Independent Claims 10, 16, and 25 recite in general a delay element coupled to a first bidirectional port and a first unidirectional port. By contrast, the Examiner readily admits that the Admitted Prior Art fails to disclose a delay element. To offset the deficiencies of the Admitted Prior Art, the Examiner cites the Thomas, et al. patent. The Examiner states that the Thomas, et al. patent includes a delay element. However, the Thomas, et al. patent does not

include a delay element as required by the claimed invention. FIGURE 1 of the Thomas, et al. patent cited by the Examiner discloses a pair of optical fibres 1a and 1b of different lengths. (See also col. 3, lines 32-36, of the Thomas, et al. patent). Neither of the optical fibres of the Thomas, et al. patent have or utilize any delay element. There is no delay element connecting the first coupler of the Thomas, et al. patent to its second coupler. Moreover, the first coupler of the Thomas, et al. patent as identified by the Examiner uses unidirectional ports and not bidirectional ports as provided in the claimed invention. Therefore, Applicant respectfully submits that Claims 10, 13-16, 19-21, 25, 27, 28, 31, 32, 34, 35, 37, and 38 are patentably distinct from the proposed Admitted Prior Art - Thomas, et al. combination.

Claims 30, 33, and 36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Admitted Prior Art Figures 2 and 3 in view of Thomas, et al. and further in view of Jutamulia. Independent Claim 10, from which Claim 30 depends; Independent Claim 16, from which Claim 33 depends; and Independent Claim 25, from which Claim 36 depends, has been shown above to be patentably distinct from the proposed Admitted Prior Art - Thomas, et al. patent. Moreover, the Jutamulia patent does not include any additional disclosure combinable with the Admitted Prior Art or the Thomas, et al. patent that would be material to patentability of these claims. In particular, the electrodes 92 disclosed in the Jutamulia patent are used to tune waveguide 74 to produce destructive interference in an output beam 86. (See col. 13, lines 11-13, of the Jutamulia patent). Moreover, the Jutamulia patent discloses waveguides 72 and 74 having different lengths to produce a delay D, as opposed to using a delay element as required in the claimed invention. (See col.

13, lines 8-9, of the Jutamulia patent). Therefore, Applicant respectfully submits that Claims 30, 33, and 36 are patentably distinct from the proposed Admitted Prior Art - Thomas, et al. - Jutamulia combination.

Applicant respectfully requests withdrawal of the finality of the present Office Action. "Before final rejection is in order a clear issue should be developed between the examiner and applicant." M.P.E.P. §706.07. A clear issue has not been developed between the Examiner and Applicant with respect to the Thomas, et al. and Jutamulia patents as the Examiner has only now used the Thomas, et al. and Jutamulia patents to support a rejection of these claims. According to M.P.E.P. §706.07, hasty and ill-considered final rejections are not sanctioned. "The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application." M.P.E.P. §706.07. "To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection." M.P.E.P. §706.07.

Applicant responded to the previous rejections of the claims and overcame the Admitted Prior Art used by the Examiner to reject these claims. Now the Examiner comes back with the Thomas, et al. and Jutamulia patents in combination with the Admitted Prior Art which the Examiner did not use as a basis for any rejection of these claims in the previous

Office Action. The Examiner now uses the Thomas, et al. and Jutamulia patents in the same manner as the Admitted Prior Art was used in the previous Office Action. Thus, the Examiner has not followed the M.P.E.P. where it states that "[s]witching from . . . one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance or a final rejection." Amendments to the claims in response to the previous Office Action did not substantially change the subject matter of the claims to force the Examiner to now use the Thomas, et al. and the Jutamulia patents in support of the claim rejections where it could not have been used in the previous Office Action.

As a result, Applicant has not been given the cooperation of the Examiner as required and has been denied an opportunity to fully address the Thomas, et al. and Jutamulia patents and associated new grounds of rejection. By not providing Applicant the capability to fully respond to the Thomas, et al. and Jutamulia patents without the assurance that the response would be considered and entered, the Examiner has prematurely cut off prosecution of the present Application. Applicant has not been given a full and fair hearing to which it is entitled and a clear issue has not been developed as required. Therefore, Applicant respectfully submits that the final rejection is premature and that the finality of the present Office Action be withdrawn.

This Response to Examiner's Final Action is necessary to address the new grounds of rejections and newly cited art in support thereof. This Response to Examiner's Final Action could not have been presented earlier as the Examiner has only

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now raised the new grounds of rejections and only now provided
newly cited art in support of the rejections to the claims.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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